

**REMARKS**

Assignee and the undersigned attorney thank Examiner Philogene for his review of this patent application. In the above amendment, claims 1-28 are cancelled without prejudice, claims 29 and 30 are amended, and new claims 31-39 are added. Accordingly, claims 29-39 are now pending. Assignee respectfully requests reconsideration of claims 29 and 30 and consideration of new claims 31-39.

**Claim Rejections**

In the Action, the Examiner rejected claims 1-3, 5, 7, 9-14, 17, 18, 20-23, and 25-30 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,623,486 to *Weaver et al.* (“*Weaver*”). The Action rejected claims 4, 6, 8, 15, 16, and 24 under 35 U.S.C. § 103 as being unpatentable over *Weaver* in view of U.S. Patent No. 6,821,278 to *Frigg et al.* (“*Frigg*”). The Action did not specifically address claim 19.

More specifically, with respect to claims 29 and 30, the Action stated that “the method steps, as set forth, would have been inherently carried out in the operation of the [*Weaver*] device, as set forth above.” Assignee respectfully disagrees with this assertion and traverses the rejection of claims 29 and 30.

**Claims 29-30**

Amended claim 29 recites:

29. A method of reducing a fracture of a bone, the method comprising:  
coupling a bone plate to the bone with a first device inserted through the bone plate and into engagement with the bone on a first side of the fracture;  
inserting a compression screw through a hole in the bone plate and into engagement with the bone on an opposite side of the fracture to adjust

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the position of the bone and surrounding tissue, wherein the hole is configured for interchangeably receiving locking and compression screws and the hole includes a thread that makes a complete revolution around the hole;

removing the compression screw from the hole and engagement with the bone; and

inserting a locking screw into the hole and into engagement with the bone, wherein threads of the hole completely surround threads of a head of the locking screw.

The Examiner asserts that *Weaver* teaches each and every element of claim 29. However, *Weaver* does not teach or suggest at least “removing the compression screw from the hole and engagement with the bone” and “inserting a locking screw into the hole and into engagement with the bone, wherein threads of the hole completely surround threads of a head a locking screw.” Accordingly, *Weaver* does not anticipate claim 29, and the rejection of claim 29 should be withdrawn.

*Weaver* describes a bone plate with two distinct types of holes: “locking holes with threads and non-locking holes.” *See* Abstract. More specifically, *Weaver* describes several embodiments of bone plates with each bone plate having “a plurality of first plate holes” and “a plurality of second plate holes.” *See, e.g.*, col. 4, ll. 45-53; col. 5, l. 67 – col. 6, l. 12; col. 6, l. 63 – col. 7, l. 8. The first plate holes are always described as having threads that mate with threads of a locking screw to secure the locking screw to the bone plate, and the second plate holes are always described as having no threads and receiving non-locking screws with non-threaded heads. *See id.*

*Weaver* twice states that a surgeon may elect to use a non-locking screw in a threaded (or first) plate hole. *See* col. 6, ll. 47-49; col. 7, ll. 44-46. However, there is no teaching or suggestion in *Weaver* to remove a non-locking screw from a hole and from engagement with

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the bone and to insert a non-locking screw into the same hole and into engagement with the bone. *Weaver* describes only one method for fracture fixation of bone:

The method for fracture fixation of bone according to the present invention comprises the steps of reducing the fracture to bring bone fragments in close apposition; compressing a bone plate against the bone with at least one first fastener to hold the fracture reduction; and securing at least one second fastener at a fixed angular relationship to the bone plate. The first fasteners are inserted before the second fasteners and both the first and second fasteners remain in bone for substantially as long as the bone plate is implanted.

Col. 3, ll. 9-17; *see also* col. 8, ll. 38-59 (claims 10-13). *Weaver* clearly discloses that the fasteners used to reduce the fracture remain in the bone. *Weaver* simply does not teach or suggest the steps of “removing the compression screw from the hole and engagement with the bone; and inserting a locking screw into the hole and into engagement with the bone. . . ,” as recited in claim 29.

Additionally, these steps are not inherent in *Weaver* nor would one skilled in the art be motivated to use a non-locking screw in a hole, remove the screw, and use a locking screw in the same hole. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original) (*see* M.P.E.P. § 2112). The Examiner’s stated rejection in the Action does not provide such a basis in fact or technical reasoning. Moreover, *Weaver* discloses providing bone plates with a plurality of holes of two different types, with the express purpose of one type being for locking screws and the other type being for non-locking screws. This would not suggest to

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one skilled in the art to carry out a method including the steps of “removing the compression screw from the hole and engagement with the bone; and inserting a locking screw into the hole and into engagement with the bone. . . ,” as recited in claim 29.

For at least the above reasons, the § 102 rejection of claim 29 as anticipated by *Weaver* should be withdrawn, and claim 29 should be allowed.

Inasmuch as claim 30 depends from and thereby includes the limitations of claim 29, claim 30 should also be allowed for at least such dependency.

### Claims 31-39

Claims 31-39 are new and all ultimately depend from claim 29. No new matter is added by these claims as support for claims 31-39 is found in the specification, for example, at pages 14-17 and original claims 1-28. Inasmuch as claims 31-39 depend from and thereby include the limitations of claim 29, claims 31-39 should also be allowed for at least such dependencies.

### Conclusion

The foregoing is submitted as a full and complete response to the Action mailed May 15, 2006. Assignee submits that claims 29-39 are in condition for allowance, and notice of allowance is respectfully requested. The preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability. If the Examiner believes there are any issues that can be resolved via a telephone conference, or there are any informalities that can be corrected by an Examiner’s amendment, please call Geoffrey Gavin at (404) 815-6046.

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The undersigned attorney believes no fees are due; however, the Commissioner is authorized to debit deposit account no. 11-0855 to the extent necessary if fees are due.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Geoffrey K. Gavin', with a stylized, flowing script.

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